

R E M A R K S

Claims 1 to 4, 6, 7, 9 to 12 and 14 to 18 as set forth in Appendix I of this paper are herewith presented for further prosecution in this case. Relative to the version of claims previously before the Examiner, Claims 16 to 18 have been added as indicated in the listing of the claims.

The subject matter of the newly added claims is supported by the claims upon which they depend, and the additional claims differ from the corresponding independent claims in that the list of plants does not encompass cherries, plums or sloes. No new matter has been added.

Claim 6 stands allowed, and Claims 3, 9 and 14 stand objected to as being dependent upon a rejected claim but were indicated as being allowable if rewritten in independent form. Claims 1, 2, 4, 7, 10 to 12 and 15 stand rejected.

The Examiner rejected Claims 1, 2, 4, 7, 10 to 12 and 15 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Motojima et al.* (US 4,866,201). More specifically, the Examiner argued:²⁾ "*Motojiuma [sic] teaches a method of applying to orchards (fruit trees) a composition comprising instant compounds of formula I. ... Motojiuma [sic] does not teach an invention comprising citrus fruit trees or an invention comprising increasing amounts of flavonoids and other phenolic compounds. ... the step of applying the compound of formula I to the fruit trees in the claim is also carried out by Motojiuma [sic] which makes it obvious that the flavonoids and other phenolic constituents would increase in the orchards of Motojiuma [sic].*"

On the one hand, applicants respectfully submit that newly added Claims 16 to 18 do not recite fruit trees such as cherries, plums or sloes. The Examiner's reasons for rejecting applicants' claims under Section 103, therefore, are not deemed to apply to the additional claims and the claims are deemed to be drawn to allowable subject matter. Favorable action is solicited.

On the other hand, applicants respectfully urge that the *Motojima et al.* reference cannot be deemed to teach or even suggest the subject matter of applicants' claims, or more specifically the treatment of certain plants including cherries, plums and sloes which are spe-

2) Office action page 2, lines 12 to 18.

cified in applicants' claims, and -as the Examiner conceded- the reference does not teach a method of increasing the content of flavonoids in a plant. The Examiner appears to allege that one would arrive at applicants' method by following the teachings and suggestions of *Motojima et al.* Applicants respectfully disagree.

The authors provide in col. 20 of the reference that the compounds according to their formula (i) may be employed to a variety of locations and plants, stating inter alia:³⁾ *"For instance, when the compound of this invention is applied onto lawns in park, playing field, golf link, airport or embankment or undergrowth grasses in orchards or pasture land, it is possible to inhibit the overluxuriant growth, to reduce the number of reaping, and/or to facilitate the mowing operations as usually required for maintenance. Further, application of the new compound of this invention onto swards can promote sideshooting and increase the planting density of swards."* It is immediately apparent that the referenced section contemplates the treatment of grasses, rather than the treatment of plants sharing the environment of the grasses to be treated. Moreover, in order to arrive at applicants' method, a person of ordinary skill in the pertinent art would not merely have to select the treatment of undergrowth grasses in orchards from the numerous possible treatments which are contemplated by the authors. In addition to selecting the particular compounds which correspond to applicants' formula (I), a person of ordinary skill would also have to select not just any orchard but an orchard in which, e.g., cherries, plums or sloes are grown, and then would have had to extend the treatment with the selected compounds such that the trees are treated along with the undergrowth. Clearly, the particularities of applicants' method are not necessarily met when a person of ordinary skill in the art followed the guidance provided by *Motojima et al.* However, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.⁴⁾ "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing

3) Col. 20, indicated lines 54 to 63, of *US 4,866,201*.

4) *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir.); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

may result from a given set of circumstances is not sufficient."⁵⁾ Following the guidelines established by the Courts to determine whether a certain result may be regarded as being inherent in the teaching of a reference it is believed to be immediately clear that a method which comprises treating "a plant selected from grapevines, cherries, plums, sloes, blueberries, strawberries, citrus fruit, paw-paw, red cabbage, broccoli, Brussels sprouts, kale, carrots, parsley, celery/celeriac, onions, garlic, tea, coffee, cacao, maté, hops, soya, oilseed rape, oats, wheat, rye, Aronia melanocarpa and Ginkgo biloba" to achieve a certain result is not inherently disclosed by the reference. Moreover, it is well settled that inherence of an advantage or property and its obviousness are entirely different questions and that an inherent advantage or property is not necessarily known or apparent to a person of ordinary skill in the art. Obviousness cannot be predicated on what is unknown.⁶⁾ Also, not only the materials used and the nature of the specific process employed but also the particular result which is obtained must be considered when determining whether a claimed method is obvious within the meaning of Section 103.⁷⁾ The methods which are defined in applicants' independent claims 1, 7 and 10, and further specified in dependent claims 2, 4, 11, 12 and 15, cannot be deemed obvious within the meaning of Section 103 because the results are neither inherent nor described or suggested in the procedures addressed in the reference, and would not have been apparent to a person of ordinary skill. It is therefore respectfully requested that the rejection be withdrawn. Favorable reconsideration of the Examiner's position is respectfully solicited.

5) *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted; emphasis added).

6) Cf. *In re Adams*, 356 F.2d 998, 148 USPQ 742 (CCPA 1966); *In re Spormann*, 363 F.2d 444, 150 USPQ 449 (CCPA 1966); *In re Shetty*, 566 F.2d 81, 195 USPQ 753 (CCPA 1977); *In re Newell*, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989); *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).

7) *In re Dillon*, 919 F.2d 688, 695, 16 USPQ2d 1897, 1903 (Fed. Cir. 1990) (*en banc*), cert. denied, 500 U.S. 904 (1991).